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Application Number	10/091,730
Filing Date	March 6, 2002
First Named Inventor	Robert De France
Title	Ground Connector
Group Art Unit	2833
Examiner Name	Felix O. Figueroa
Attorney Docket Number	DELRI/109/US

ENCLOSURES

- ☒ Response to Office Action (After Final Rejection) (Amendment Under 37 C.F.R. 1.116) ☐ Preliminary Amendment
- ☐ Information Disclosure Statement ☒ Postcard reflecting enclosures
- ☐ Other:

☒ It is hereby petitioned that any required extension of time be granted for filing the amendment. An extension of -0- month(s) having a fee of \$ -0- appears required.

☐ A check in the amount of \$ -0- is attached. Please credit any overpayment to Deposit Account 16-2563 of Alix, Yale & Ristas, LLP.

- The Commissioner is hereby requested and authorized to charge Deposit Account 16-2563 of Alix, Yale & Ristas, LLP for any fee, not enclosed herewith, due for any reason in connection with the amendment or this or any other document accompanying the amendment, including (a) any filing fees under 37 CFR 1.16 for the presentation of extra claims and (b) any patent application processing fees under 37 CFR 1.17. **A duplicate copy of this sheet is attached.**

SIGNATURE OF APPLICANT, ATTORNEY OR AGENTFirm or
Individual name

Guy D. Yale

Reg. No.

29,125

Signature

Date

May 9, 2003

Attorney's Docket No.

29,125

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited on the date above with the United States Postal Service as First Class Mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450".

Typed or Printed Name

Guy D. Yale

Reg. No.

29,125



**Response Under 37 C.F.R. 1.116 (After Final)
Expedited Procedure Examining Group 2833**

Attorney Docket Number: DELRI/109/US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of
Robert De France
Serial No.10/091,730

Examiner: Felix O. Figueroa

Group Art Unit: 2833

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Filing Date: March 6, 2002

For: GROUND CONNECTOR

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Sir:

RESPONSE TO OFFICE ACTION (AFTER FINAL REJECTION)
(AMENDMENT UNDER 37 C.F.R. 1.116)

In response to the Office Action dated February 26, 2003 Applicant respectfully request entry and consideration of the following Request to Withdraw Finality, Amendment, and Remarks.

**REQUEST TO WITHDRAW FINALITY AND TO CONSIDER THE ENCLOSED
RESPONSE**

This Request to Withdraw Finality MPEP 706.07(d) is necessitated by the following:

1. Applicant filed a Response to Office Action on August 8, 2002.
2. Examiner Figueroa, who issued the Final Rejection, rejected claim 4 and 12 as being obvious over Izraeli (United States Patent No. 4,103,986), wherein the Examiner stated, at page 5, that “[I]t would have been obvious... since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70”
3. This application of In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) is improper given court holdings that there are no *per se* rules of unpatentability. In re Durden 226 USPQ 359, 362 (Fed. Cir. 1985); In re Ochiai, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) (“The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention—including all its limitations—with the teachings of the prior art, flouts section 103 and the fundamental case law applying it.”); In re Cofer, 354 F.2d 664, 667, 148 USPQ 268, 271 (CCPA 1966) (“[I]t is facts appearing in the record, rather than prior decisions in and of themselves, which must support the legal conclusion of obviousness under 35 U.S.C. § 103.”). Each claimed invention must be considered on its own merits and in every instance, the test for patentability under § 103 is the same: “whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention.” In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991).

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4. The "Final Rejection", therefore, does not comport with the requirements for a Final Action.

The Examiner's attention is respectfully directed to the following sections/passages from 37 C.F.R., and the MPEP laying out the standards applicable to a final rejection:

37 C.F.R. §1.104 Nature of Examination

(a) Examiner's action. (1) On taking up an application for examination or a patent in a reexamination proceeding, the Examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

MPEP §706.07 Final Rejection

Before final rejection is in order a clear issue should be developed between the Examiner and Applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the Applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first Office Action and the references fully applied...

The Applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the Examiner to that end, and not be prematurely cut off in the prosecution of his or her case... The Examiner should never lose sight of the fact that in every case the Applicant is entitled to a full and fair hearing, and that a clear issue between Applicant and Examiner should be developed, if possible, before appeal ...

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to

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such an extent that Applicant may readily judge the advisability of an appeal unless a single previous Office Action contains a complete statement supporting the rejection...

37 C.F.R. §1.113 Final rejection or action.

(b) In making such final rejection, the Examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor.

Basis for Request to Withdraw Final Rejection

The second (final) rejections of Applicant's claims fail to meet the statutory and regulatory standards governing patent examination since the Examiner has clearly not met his burden with respect to establishing a *prima facie* case with regard to at least claims 4 and 12. The current Office Action is therefore incomplete, and finality has been imposed prematurely. In particular, Examiner Figueroa did not show any proper motivation or suggestion for the proposed modification of Israeli in rejecting claims 4 and 12 under 35 U.S.C. §103. This is clear from the Examiner's statement that "[I]t would have been obvious... since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70". The Ochiai court is quite adamant in stating that such *per se* rules of obviousness are "legally incorrect and must cease. Any administrative convenience is simply inconsistent with section 103, which, according to Graham and its progeny, entitles an applicant to issuance of an other wise proper patent unless the PTO establishes that the invention as claimed (emphasis original) in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations" (emphasis added). Ochiai at 1572.

The final rejection therefore impermissibly ignores the relevant law, rules, and procedure for asserting a *prima facie* case of obviousness.

A final rejection that fails to comply with all relevant rules and regulations imposes an undue burden on the Applicant. Non-compliant rejections that are made